



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

09/173,858

10/16/1998

BART ALAN MELTZER

OIN 1004-1

4734

22470 7590 09/02/2009  
HAYNES BEFFEL & WOLFELD LLP  
P O BOX 366  
HALF MOON BAY, CA 94019

EXAMINER

HUYNH, CONG LAC T

ART UNIT

PAPER NUMBER

2178

MAIL DATE

DELIVERY MODE

09/02/2009

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

UNITED STATES PATENT AND TRADEMARK OFFICE

---

Commissioner for Patents  
United States Patent and Trademark Office  
P.O. Box 1450  
Alexandria, VA 22313-1450  
[www.uspto.gov](http://www.uspto.gov)

**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Application Number: 09/173,858  
Filing Date: October 16, 1998  
Appellant(s): MELTZER ET AL.

---

Ernest J. Beffel, Jr.  
For Appellant

**EXAMINER'S ANSWER**

This is in response to the appeal brief filed 12/16/08 appealing from the Office action mailed 10/09/08.

**(1) Real Party in Interest**

A statement identifying by name the real party in interest is contained in the brief.

**(2) Related Appeals and Interferences**

The following are the related appeals, interferences, and judicial proceedings known to the examiner which may be related to, directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal:

The prior appeal of this case on 6/6/05 was affirmed by the Board on 8/31/06.

**(3) Status of Claims**

The statement of the status of claims contained in the brief is correct.

**(4) Status of Amendments After Final**

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

**(5) Summary of Claimed Subject Matter**

The summary of claimed subject matter contained in the brief is correct.

**(6) Grounds of Rejection to be Reviewed on Appeal**

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

**(7) Claims Appendix**

The copy of the appealed claims contained in the Appendix to the brief is correct.

**(8) Evidence Relied Upon**

McKendrick, *Banks begin to play with XML*, Bank Technology News, Sep 1998, Vol. 11, Iss. 9, pg. 6, 2 pgs,

Art Unit: 2178

W3C, *Extensible Markup Language (XML) 1.0*, 2/10/98, pages 1-37.

### **(9) Grounds of Rejection**

The following ground(s) of rejection are applicable to the appealed claims:

#### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 73-74 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with

the enablement requirement. The claim(s) contains subject matter which was not

described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Independent claim 73 is directed to specification of an interface to an operation rather than an interface to plural transaction processes. Applicants point out the support in the specification at pages 17, 25-27, and 86.

However, as disclosed in these pages, particularly page 25, lines 25-26, page 26, lines 7-9, 43-48, page 27, lines 1-2, 9-12, when the service for only an input document or only an output document, then an operation is performed. But when the service is for both an input document and an output document as in the claim, that means “by way of input and output documents”, then multiple operations should be performed for input and output documents. The claimed limitation, therefore, is not consistent with the specification.

Art Unit: 2178

Dependent claim 74 is rejected for fully incorporating the deficiencies of their base claim.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 73-74 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding independent claim 73, it is unclear how an operation is performed for two processes for an input document and an output document.

Dependent claim 74 is rejected for fully incorporating the deficiencies of their base claim.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under

Art Unit: 2178

37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1-16, 61-72 remain rejected under 35 U.S.C. 103(a) as being unpatentable over McKendrick, *Banks begin to play with XML*, Bank Technology News, Sep 1998, Vol. 11, Iss. 9, pg. 6, 2 pgs, in view of W3C, *Extensible Markup Language (XML) 1.0*, 2/10/98, pages 1-37 (from the IDSs).

Regarding independent claim 1, McKendrick discloses:

- a machine-readable specification of an interface to transaction processes stored in memory accessible by at least one node in the network, including interpretation information providing a definition of an input document, and a definition of an output document (pages 1-2: McKendrick discloses applying XML in financial area to provide better bank services and utilizing XML for on-line business transactions involved with manipulation and transfer of data in the Internet such as purchase orders, invoices, and customer information. The purchase orders are considered as input documents, and the invoices are considered as output documents of the purchase orders in business transactions. Since the purchase orders as well as the invoices, which are the input and output documents, are in XML, they definitely include information providing the definition for such a document according to XML structures. And since the transaction

Art Unit: 2178

documents are in XML format, these documents are machine-readable documents and should be stored in memory of a server accessible by at least one node in the network)

McKendrick does not explicitly disclose that the definitions of the input document and the output document comprising respective descriptions of sets of storage units and logical structures for the sets of storage units.

W3C discloses that each XML document comprises respective descriptions of set of storage units and logical structures for the set of storage units (page 3, Introduction: “XML documents are made up of *storage units* called entities, which contain either *parsed or unparsed data*. Parsed data is made up of characters, some of which form character data, and some of which form *markup*. *Markup encodes a description of the document’s storage layout and logical structure*. XML provides a mechanism to impose constraints on the storage layout and logical structure.”)

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to have combined McKendrick into W3C for the following reason.

McKendrick discloses the transaction documents such as the purchase orders and the invoices in XML format for a business transaction over the Internet where a user can search and buy an item on-line, and W3C discloses the structures of an XML document which comprises storage units and the logical structures for the set of storage units.

This motivates to combine W3C into McKendrick for supporting the business transaction documents in XML format using the XML characteristics disclosed in W3C.

Art Unit: 2178

Regarding claim 2, which is dependent on claim 1, McKindrick does not disclose that the interpretation information includes data type specification for at least one logical structure in the definitions of the input and output document.

W3C discloses that each XML document contains one or more elements which are delimited by starts-tags and end-tags, and each element has a *type* identified by name called generic identifier and may have a set of *attribute specification* (page 13, Logical structure).

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to have combined McKendrick into W3C for supporting the business transaction documents in XML format using the XML characteristics disclosed in W3C.

As mentioned in claim 1, since the documents used in the purchase transaction in McKindrick are in XML format, these documents inherit the features of a general XML document as disclosed in W3C. This is applied for all the claims relating to the transaction document structures and W3C is used for rejecting.

Regarding claim 3, which is dependent on claim 1, W3C discloses that the interpretation information includes at least one data structure mapping predefined sets of storage units for a particular logical structure in the definition of the input and output documents, to respective entries in a list (pages 14-17).



Art Unit: 2178

Regarding claims 4 and 5, which are dependent on claim 1, McKindrick and W3C do not disclose explicitly that a repository in memory accessible by at least one node in the network storing a library of logical structures, interpretation information for logical structures, and the identifier of a transaction. However, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to have modified McKindrick and W3C to include a repository in memory for storing logical structures and the identifier of a transaction interface since it was well known in the art that any defined data for a program in a network should have a name for identifying and should be stored in a memory of a server for using later on such as retrieving data, identifying data, or manipulating data.

Regarding claim 6, which is dependent on claim 1, W3C discloses that the machine readable specification includes a document compliant with a definition of an interface document including logical structures for storing an identifier of the interface, and for storing at least one of specifications and references to specifications of a set of one or more transactions supported by the interface (page 13).

Regarding claim 7, which is dependent on claim 6, McKindrick does not disclose a reference to a specification of a particular transaction, and the specification of the particular transaction includes a document including logical structures for storing at least one of definitions and references to definitions input and output documents for the particular transaction. Instead, McKindrick discloses *applying XML for business-to-*

Art Unit: 2178

*business transaction where data such as purchase orders and invoices are manipulated and transferred over the Internet (page 2).*

W3C discloses that each XML document comprises respective descriptions of set of storage units and logical structures for the set of storage units (page 3, Introduction: “XML documents are made up of *storage units* called entities, which contain either *parsed or unparsed data*. Parsed data is made up of characters, some of which form character data, and some of which form *markup*. *Markup encodes a description of the document’s storage layout and logical structure*. XML provides a mechanism to impose constraints on the storage layout and logical structure.”)

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to have combined W3C into McKindrick to include a reference to a specification of a particular transaction which has logical structures for storing at least one of definitions and references to documents as in W3C for the particular business transaction as in McKindrick since a reference is considered as a name or an identifier and the transaction documents in McKindrick such as the purchase orders and the invoices, considered as the input and output documents, must have a document name for identifying purpose.

Regarding claim 8, which is dependent on claim 1, W3C discloses that the storage units comprise parsed data (page 3, Introduction: “XML documents are made up storage units called entities, which contain either *parsed or unparsed data*...”).

Art Unit: 2178

Regarding claim 9, which is dependent on claim 1, McKindrick does not explicitly disclose the parsed data in at least one of the input and output documents comprises:

- character data encoding text characters in the one of the input and output document
- markup data identifying sets of storage units according to the logical structure of the one of the input and output documents

Instead McKindrick discloses the business transactions involved with manipulation and transfer data such as purchase orders and invoices where invoices are considered as the output documents produced from the data portion of the purchase orders, which are considered as the input document (pages 1-2).

W3C discloses that the parsed data comprises:

- character data encoding text characters in XML documents (page 3, Introduction: "*XML documents* are made up storage units ...*Parsed data* is made up characters, some of which form *character data* ..."; page 6, Characters: "A parsed entity contains text, a sequence of characters, which may represent markup or character data
- markup data identifying sets of storage units according to the logical structure of XML documents (page 3, Introduction: "*XML documents* are made up storage units ... *Parsed data* is made up characters, some of which form character data, and some of which form *markup*. *Markup* encodes a description of the document's storage layout and logical structure ...")

Art Unit: 2178

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to have combined W3C into McKindrick since the XML business documents in McKindrick which function as input and output documents should comprise parsed data with claimed features since these features are characteristics of an XML document as taught in W3C.

Regarding claim 10, which is dependent on claim 9, W3C discloses that at least one of the sets of storage units encodes a plurality of text characters providing a natural language word (page 6, Document, page 7, Characters and page 8, Character Data and Markup: since the storage units encodes by character data and markup which are text, the storage units provide a natural language word).

Regarding claim 11, which is dependent on claim 8, W3C discloses that the interpretation information for at least one of the sets of storage units identified by a particular logical structure of at least one of the input and output documents, encodes respective definitions for sets of parsed characters (page 9: "the function of the markup in an XML document is to describe its storage and logical structure and to associate attribute-value pairs with its logical structures. XML provides a mechanism, the document type declaration, to *define constraints on the logical structure* and to support the use of predefined storage units ... the XML document type declaration contains or points to markup declarations that provide a grammar for a class of documents. This grammar is known as a *document type definition, or DTD ...*").

Art Unit: 2178

Regarding claim 12, which is dependent on claim 8, W3C discloses that the storage units comprise unparsed data (page 3, Introduction: “XML documents are made up storage units called entities, which contain either parsed or unparsed data...” page 20, Physical Structures).

Regarding claim 13, which is dependent on claim 1, as mentioned in claims 4 and 5 above, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to have modified McKindrick and W3C to include a repository in memory for storing all data related to the purchase transactions since it was well known in the art that any defined data for a program in a network should be stored in a memory of a server for using later on such as retrieving data, identifying data, or manipulating data.

Regarding claim 14, which is dependent on claim 13, W3C discloses that the repository of document types includes a document type for identifying participant process in the network (page 9: “XML provides a mechanism, the document type declaration, to define constraints on the logical structure and to support the use of predefined storage units”).

Regarding claim 15, which is dependent on claim 1, W3C discloses that the definitions of the input and output documents comprise document type definitions compliant with a standard Extensible Markup Language XML (page 9: “XML provides a mechanism, the document type declaration, to define constraints on the logical structure and to support

Art Unit: 2178

the use of predefined storage units ... the XML document type declaration contains or points to markup declarations that provide a grammar for a class of documents. This grammar is known as a document type definition, DTD ... the DTD fro a document consists of both subsets taken together”).

Regarding claim 16, which is dependent on claim 1, W3C discloses that the machine readable data structure including interpretation information comprises a document organized according to a document type definition compliant with a standard Extensible Markup Language XML (page 9: an XML document is a machine readable data structure organized according to a DTD compliant with the standard Extensible Markup Language).

Regarding independent claim 61, McKindrick does not disclose explicitly:

- defining a machine readable definition of an input document for a node in the network including resources to execute a process in the transaction, and a machine readable definition of an output document for the node, the definitions the input and output documents comprising respective descriptions of sets of storage units and logical structures for the sets of storage units
- providing interpretation information for the logical structures to the node

Instead McKindrick discloses applying XML in financial area to provide better bank services and utilizing XML for on-line business transactions involved with manipulation and transfer of data in the Internet such as purchase orders, invoices, and customer

Art Unit: 2178

information (pages 1-2). The purchase orders in McKendrick are considered as input documents, and the invoices are considered as output documents of the purchase orders in business transactions. Since the purchase orders as well as the invoices, which are the input and output documents, are in XML format, they definitely include information to provide the definition for said documents according to XML structures. And since the transaction documents are in XML format, these documents are machine-readable documents and should be stored in memory of a server accessible by at least one node in the network.

W3C discloses:

- defining a machine readable definitions of documents comprising respective descriptions of sets of storage units and logical structures for the sets of storage units (page 3, Introduction and page 9: XML documents are made up of storage units which contain either parsed or unparsed data where parsed data is made up characters some of which form character data, and some of which form markup to encode a *description of the document storage layout and logical structures*).
- providing interpretation information for the logical structures (page 9: the function of the markup in an XML document is to associate *attribute-value* pairs with its logical structures)

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to have combined McKendrick into W3C for the following reason.

McKendrick discloses the transaction documents such as the purchase orders and the

Art Unit: 2178

invoices in XML format for a business transaction over the Internet where a user can

search and buy an item on-line and W3C discloses the structures of an XML document

which comprises storage units and the logical structures for the set of storage units.

This motivates to combine W3C into McKendrick for supporting the business transaction documents in XML format using the XML characteristics disclosed in W3C.

Claims 62-71 are for a method of claims 2-5, 8-12, 15, and are rejected under the same rationale.

Regarding claim 72, which is dependent on claim 61, McKindrick and W3C do not disclose:

- providing a parser to generate event signals in response to logical structures in the definition of the input document
- providing event listener program which respond to the event signals to execute the process

Instead McKindrick discloses the Internet business transactions via purchase orders and invoices in XML format where the purchase orders and the invoices are considered as input documents and output documents (pages 1-2).

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to have modified McKindrick to include “providing a parser to generate event signals in response to logical structures...” and “providing event listener program which



Art Unit: 2178

respond to the event signals to execute the process” for the following reason. The fact that McKendrick executes the transaction program by running the XML transaction documents which include logical structures suggests said parser and said event listener program as claimed, which are the must programs in the executing process.

Claims 73-74 are rejected under 35 U.S.C. 103(a) as being unpatentable over McKendrick, *Banks begin to play with XML*, Bank Technology News, Sep 1998, Vol. 11, Iss. 9, pg. 6, 2 pgs, in view of W3C, *Extensible Markup Language (XML) 1.0*, 2/10/98, pages 1-37 (from the IDSs).

Regarding independent claim 73, McKendrick discloses:

- a machine-readable specification of an interface to transaction processes stored in memory accessible by at least one node in the network, including interpretation information providing a definition of an input document, and a definition of an output document (pages 1-2: McKendrick discloses applying XML in financial area to provide better bank services and utilizing XML for on-line business transactions involved with manipulation and transfer of data in the Internet such as purchase orders, invoices, and customer information. The purchase orders are considered as input documents, and the invoices are considered as output documents of the purchase orders in business transactions. Since the purchase orders as well as the invoices, which are the input and output documents, are in XML, they definitely include information providing the definition

Art Unit: 2178

for such a document according to XML structures. And since the transaction documents are in XML format, these documents are machine-readable documents and should be stored in memory of a server accessible by at least one node in the network)

McKendrick does not explicitly disclose that the definitions of the input document and the output document comprising respective descriptions of sets of storage units and logical structures for the sets of storage units and the specification of an interface to an operation instead of plural transaction processes.

W3C discloses that each XML document comprises respective descriptions of set of storage units and logical structures for the set of storage units (page 3, Introduction: “XML documents are made up of *storage units* called entities, which contain either *parsed or unparsed data*. Parsed data is made up of characters, some of which form character data, and some of which form *markup*. *Markup encodes a description of the document’s storage layout and logical structure*. XML provides a mechanism to impose constraints on the storage layout and logical structure.”)

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to have combined McKendrick into W3C for the following reason.

McKendrick discloses the transaction documents such as the purchase orders and the invoices in XML format for a business transaction over the Internet where a user can search and buy an item on-line, and W3C discloses the structures of an XML document which comprises storage units and the logical structures for the set of storage units.

This motivates to combine W3C into McKendrick for supporting the business transaction

Art Unit: 2178

documents in XML format using the XML characteristics disclosed in W3C. Further, since McKendrick and W3C provide plural transaction processes, it is clear that one operation of one transaction is included in these transaction processes either for processing an input document or processing an output document.

Regarding claim 74, which is dependent on claim 73, McKendrick does not disclose that the interpretation information includes data type specification for at least one logical structure in the definitions of the input and output document.

W3C discloses that each XML document contains one or more elements which are delimited by starts-tags and end-tags, and each element has a *type* identified by name called generic identifier and may have a set of *attribute specification* (page 13, Logical structure).

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to have combined McKendrick into W3C for supporting the business transaction documents in XML format using the XML characteristics disclosed in W3C.

#### **(10) Response to Argument**

Regarding the 103 (a) rejections of claims 1-16 and 61-74, Appellants argue that Examiner does not give any consideration to sworn testimony in sections 13-16 and 19 of the declaration and ignores the submitted evidence (Brief, page 20).

Art Unit: 2178

This is not true. The Examiner considered the testimony in sections 13-16 and 19 of the declaration. However, the evidence submitted for these sections are merely program coding dated in 1997 and 1998 and there is no statement along with the dates verifying that these programs are tested and worked successfully.

Moreover, as mentioned in the office action 10/9/08, the article "Common Business Language" in Exhibit C of one of the inventors, Terry Allen, dated in December 5, 1997 stated that the early version of CBL is unstable and merely a sketch as in December 1997. This part is repeated as follows:

*"Also, as shown in Exhibit C, the article "Common Business Language (CBL)" dated December 5, 1997, the early version of CBL is unstable and merely a sketch, "As of the date of this document's writing, this specification was still unstable, and the details of the linking attributes in the CBL DTDs should be considered as a sketch" (emphasis added)"*

It is noted that sections 13-16, 19 are the testimony regarding preparing for a demonstration to Ingram Micro in January 21, 1998. Therefore, in *only one month* from December 5, 1997 to January 21, 1998, at most the *unstable* CBL with CBL DTDs *merely a sketch as admitted by one of the inventors* Terry Allan and submitted evidence, can be only proper for showing in demonstration regarding a CBL which is under developing at the time of demonstration without requiring a complete testing. As seen above, the submitted evidence provided in the Exhibits is not sufficient for showing a complete product successfully working with testing and proving reduce to practice of

Art Unit: 2178

the invention before the effective date of McKendrick and so not sufficient to remove McKendrick as a reference.

Appellants argue that Examiner ignored sections 14-17 of the declaration and give no weight to Exhibit I, slide 30 which “provide well-corroborated testimony of an actual reduction to practice on or before July 25, 1998 (Brief, page 22).

Examiner respectfully disagrees.

Examiner considered the evidence. However, the slide 30 is merely a PowerPoint slide that can be made for presentation purpose and slide 31 is a piece of code. These slides are *not an evidence of a complete product that is guaranteed that it worked with testing* (see office action dated 1/3/08, repeated in office action 10/9/08, Response to Argument).

Appellants also state that Examiner “erred in giving no probative weight to Exhibit I, slide 30 because she only criticized slide 30 isolation” (Brief, page 22).

As mentioned above, the slides are “*not an evidence of a complete product that is guaranteed that it worked with testing*”, and thus the provided evidence is not sufficient to prove reduce to practice.

Appellants state that the Examiner “further erred in failing to consider the similarities among the imdesc.xml data structure, dated January 2, 1998, the slide 30 data structure, disclosed July 25, 1998, and the data structure disclosed on page 45 of this

Art Unit: 2178

application” where these similarities demonstrate that the January 2, 1998 embodiment was ready to work for its intended purpose (Brief, page 22).

In response, even though there are similarities, these similarities are merely evidence to show that the January 2, 1998 embodiment was ready to work for its intended purpose, which is the demonstration in January 1998. According to the article “Common Business Language (CBL)” in Exhibit C, the CBL version in December, 1997 is unstable and merely a sketch:

*“As of the date of this document’s writing, this specification was still unstable, and the details of the linking attributes in the CBL DTDs should be considered as a sketch”* (emphasis added).

In *only less than one month* from December 5, 1997 to January 2, 1998, the January 2, 1998 embodiment, which is an *unstable* CBL with CBL DTDs *merely a sketch as admitted by Terry Allen one of the inventors*, at most can be “ready to work for its intended purpose” for demonstration only where the CBL is still under developing, not for proving of reducing to practice.

Appellants argue that the prototype prepared for demonstration to Ingram Micro is enough since the witnesses have testified that they tested the prototype sufficiently to appreciate that it was workable. There is no need to submit evidence of a complete product that is guaranteed that it worked with testing (Brief, page 23).

In response, though evidence submitted is testified by witnesses, the testimony is not reliable since the CBL in December 5, 1997 is still unstable and merely a sketch

according to Terry Allen, one of the inventors, in the article "Common Business Language (CBL)" in Exhibit C:

*"As of the date of this document's writing, this specification was still unstable, and the details of the linking attributes in the CBL DTDs should be considered as a sketch"* (emphasis added).

Therefore, the prepared prototype is *at most* suitable for demonstration in January 21, 1998 only where the CBL was still under developing and appreciated to be "workable" since said CBL is still unstable and CBL DTDs are merely a sketch a month ago.

Appellants argue that while they have not attempted to prove that VEO had a complete product in January 1998, they have proven that these inventors 1997 concept was tested before McKendrick was published, which is enough to remove McKendrick as a reference (Brief, page 23).

Examiner respectfully disagrees.

In order to remove the McKendrick reference, Appellants should submit a declaration with evidence to show either reduce to practice or conception coupled to due diligence of the invention prior the effective date of the McKendrick reference.

The evidence to prove reduce to practice submitted before is not sufficient to remove the McKendrick reference as mentioned in the office action dated 1/3/08 and 10/9/08.

The conception of the invention in 1997 may be proven by the submitted evidence.

However, a declaration for showing conception coupled with the due diligence is not submitted as suggested in the office action 10/9/08. As known, evidence for reduce to

Art Unit: 2178

practice is not sufficient. Appellants do not submit a declaration and evidence for conception coupled to due diligence prior the effective date of McKendrick. The McKendrick, thus, can't be removed as a reference.

Appellants argue that the brief article of McKendrick in combination with the XML 1.0 fails to provide a written description or enabling disclosure of what Appellants claim. In response, Appellants are invited to see the Board's decision on 8/31/06 regarding how the combination of McKendrick and W3C discloses the claimed invention.

Appellants argue that the Examiner erred when refusing to consider the substantial evidence submitted and that it is "black letter law that an examiner must not apply *res judicata* when new evidence is submitted after appeal" (Brief, page 24).

The Examiner respectfully disagrees.

The Examiner considered new submitted evidence. However, the evidence is not persuasive and not sufficient to remove the McKendrick as mentioned in the office action (section Response to Arguments) on 1/3/08 and 10/9/08. Regarding *res judicata*, it is noted that after the Board's decision affirming the case on 8/31/06, no claim amendment was filed with the RCE on 7/23/07. The claims in the RCE having no change are a duplicate of the claims presented earlier to the Board of Appeals. The art rejection, therefore, is still the same as in the rejection on the claims presented earlier to the Board of Appeal. Applying *res judicata* in the office action on 1/3/08, thus, is proper. See MPEP 706.03 (w).



Appellants argue that the Examiner's interpretation of McKendrick is false since Microsoft advocates XML-RPC technology, which "could readily be practiced without using VEO's claimed technology." Therefore, the Microsoft's quote in McKendrick refers to XML-RPC technology of Microsoft applied to commercial transactions (Brief, page 25).

In response, it is noted that the passage in McKendrick merely shows that XML is a very suitable for business applications *after observing* successful applying of XML to financial institutions such as American Century Investments, Discover Brokerage Direct, Rowe Price, Citibank, etc. that provide these institutions benefits such as viewing more detail description, running much more rapidly compared with without using XML (page 1 of McKendrick). Then, McKendrick cites some experts' prospect about XML in future business applications (page 2 of McKendrick). At the end, McKendrick uses a part of Microsoft's report, "Customer services are now migrating to Web sites from call centers and physical locations" and "And, because most of these business applications involve manipulation and transfer of data such as purchase orders, invoices, customer information and appointments XML will allow a rich array of business applications to be implemented" as a support to his conclusion, "As such, XML may be just the ticket for providing better customer service" (emphasis added). There is no indication that XML mentioned in McKendrick should be XML-RPC technology as argued.

Art Unit: 2178

Appellants argue that McKendrick was writing about what would happen in the future when using XML instead of giving a written description of something that already existed, and also that “the use of XML was primarily buzz and potential, not working products” (Brief, page 26).

In response, as mentioned above, McKendrick cites that since 1997 when XML, a web lingo, was unveiled to September 1998, the time of the article, financial institutions such as such as American Century Investments, Discover Brokerage Direct, Rowe Price, Citibank, etc. that apply XML to their business applications receive benefits such as viewing more detail description, running much more rapidly compared with without using XML (page 1 of McKendrick). Though the use of XML “was primarily buzz” at the beginning, the application of XML to business environment is so promising that some experts including Ronal Whiting, president and CEO of CommerceNet “believe XML will prove to be a boon for e-commerce applications” (page 2 of McKendrick). Or Citibank's Vice President Dan Schutzer notes that, “We are very excited at the prospect of XML to the next generation of Web documents, supporting a simpler means for communication” (page 2 of McKendrick). Clearly, McKendrick was writing about something already existed and about what would happen in the future based on the things already existed.

Appellants argue that the 112, first paragraph and second paragraph rejections on claims 73-74 are not proper.

The 112, first paragraph and second paragraph rejections have been withdrawn since the arguments are persuasive.

**(11) Related Proceeding(s) Appendix**

Copies of the court or Board decision(s) identified in the Related Appeals and Interferences section of this examiner's answer are provided herein.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/Cong-Lac Huynh/  
Primary Examiner, Art Unit 2178  
8/28/09

Conferees:

/Stephen S. Hong/

Supervisory Patent Examiner, Art Unit 2178

Stephen Hong

/William L. Bashore/

Supervisory Patent Examiner, Art Unit 2175